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09/708,235	11/07/2000	Kevin Calloway	03-10074	1158
36212 7590 05/01/2009 LAW OFFICES OF DAVID L. HOFFMAN 28494 WESTINGHOUSE PLACE SUITE 204 VALENCIA, CA 91355				
EXAMINER ALVAREZ, RAQUEL				
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1 UNITED STATES PATENT AND TRADEMARK OFFICE  
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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
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8 *Ex parte* KEVIN CALLOWAY, JASON MCNAMARA, ERGON COPELAND,  
9 ANTHONY FRANCO, ZVULUN HALFON, SCOTT JOHNSON,  
10 RONALD KEWISH, and RICHARD WILSON  
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13 Appeal 2009-0171  
14 Application 09/708,235  
15 Technology Center 3600  
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18 Decided: <sup>1</sup> May 1, 2009  
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21 Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.  
22 MOHANTY, *Administrative Patent Judges*.  
23 FETTING, *Administrative Patent Judge*.

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<sup>1</sup> The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

DECISION ON APPEAL

STATEMENT OF THE CASE

Kevin Calloway, Jason McNamara, Ergon Copeland, Anthony Franco, Zvulun Halfon, Scott Johnson, Ronald Kewish, and Richard Wilson (Appellants) seek review under 35 U.S.C. § 134 of a non-final rejection of claims 1-63 and 71-78, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We REVERSE.

The Appellants invented a way for automated creation and distribution of individualized multimedia messages and content over a network. (Specification 2: 7-8).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A system for creating and distributing a series of individualized multimedia messages over a computer network to a plurality of recipients, comprising:

(a) a recipient information repository with unique recipient information for at least a first and second recipient;

(b) a multimedia content repository with computer files comprising at least one of text and graphics files, and further comprising at least one of audio and video files; and

(c) means for creating and delivering individualized multimedia content over said computer network to each of the plurality of recipients,

wherein said multimedia content is assembled from selected elements within the multimedia content repository

which are selected in response to individual information about each of said recipients

whose individual information is extracted from the recipient information repository.

This appeal arises from the Examiner's Non-Final Rejection, mailed August 16, 2006. The Appellants filed an Appeal Brief in support of the appeal on October 29, 2007. An Examiner's Answer to the Appeal Brief was mailed on February 15, 2008. A Reply Brief was filed on March 20, 2008.

#### PRIOR ART

The Examiner relies upon the following prior art:

Hibbeler                      US 6,067,348              May 23, 2000

Smith                        US 6,725,381 B1      Apr. 20, 2004

#### REJECTIONS

Claims 1-15, 18-33, 35-63, and 71-78 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hibbeler and Official Notice.

Claims 16, 17, 34, 35, and 75-78 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hibbeler, Smith, and Official Notice.<sup>2</sup>

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<sup>2</sup> The Examiner did not explicitly include Official Notice in this rejection. These claims depend from the claims in the prior rejection that is based on Official Notice, and therefore this rejection must implicitly be similarly based on Official Notice at least as to the subject matter incorporated from the parent claims.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-15, 18-33, 35-63, and 71-78 under 35 U.S.C. § 103(a) as unpatentable over Hibbeler and Official Notice.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 16, 17, 34, 35, and 75-78 under 35 U.S.C. § 103(a) as unpatentable over Hibbeler, Smith, and Official Notice.

These issues turn primarily on whether Hibbeler describes distributing multimedia.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

*Facts Related to Claim Construction*

01. The disclosure contains no lexicographic definition of “multimedia.”
02. The ordinary and customary meaning of “multimedia” as a noun is the combined use of media.<sup>3</sup>

*Hibbeler*

03. Hibbeler is directed to personalization of an outbound audio message (Hibbeler 1:6-8).

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<sup>3</sup> *American Heritage Dictionary of the English Language* (4<sup>th</sup> ed. 2000).

04. Hibbeler describes personalizing a message by storing a message body, a plurality of greeting segments, assigning a unique index number to each greeting segment, recalling the message body, recalling a greeting segment using the unique index number, and combining the greeting segment and the message body to form a personalized message (Hibbeler 2:4-12).

05. Hibbeler describes its distribution of its messages using a message controller, a telecommunications card, and a communication link. In the preferred embodiment, the communication link is a telephone line. The telecommunications card is capable of handling communications over multiple phone lines and hence able to rapidly transmit outbound messages. In the preferred embodiment, the telecommunications card is a telephony card capable of transmitting telephone messages over a telephone line. In an alternative embodiment, the telecommunications card is an Internet card capable of transmitting messages in a digital format over the Internet (Hibbeler 6:15-40).

*Smith*

06. Smith is directed to a mechanism by which a specific intended recipient of a delivered document can be authenticated without prior participation by the intended recipient (Smith 1:6-10).

*Facts Related To Differences Between The Claimed Subject Matter And The Prior Art*

07. Neither reference describes distributing multimedia.

*Facts Related To The Level Of Skill In The Art*

08. Neither the Examiner nor the Appellants has addressed the level of ordinary skill in the pertinent arts of systems analysis and programming, multimedia data design and processing, and data communications. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

## PRINCIPLES OF LAW

### *Claim Construction*

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily)

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be

construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

*Obviousness*

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: “[1] the scope and content of the prior art are to be determined; [2] differences between the prior art and the claims at issue are to be ascertained; and [3] the level of ordinary skill in the pertinent art resolved.” 383 U.S. at 17. *See also KSR*, 127 S.Ct. at 1734. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 1739.

“When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740.

“For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve



1 similar devices in the same way, using the technique is obvious unless its actual  
2 application is beyond his or her skill.” *Id.*

3 “Under the correct analysis, any need or problem known in the field of  
4 endeavor at the time of invention and addressed by the patent can provide a reason  
5 for combining the elements in the manner claimed.” *Id.* at 1742.

6 ANALYSIS

7 *Claims 1-15, 18-33, 35-63, and 71-78 rejected under 35 U.S.C. § 103(a) as*  
8 *unpatentable over Hibbeler and Official Notice.*

9 The Examiner found that Hibbeler described the limitations of claim 1 except  
10 for messages in graphic and video format. The Examiner took official notice that it  
11 is old and well known to deliver messages in graphic and video format in order to  
12 provide a visual representation of the data received. The Examiner concluded that  
13 it would have been obvious to a person of ordinary skill in the art at the time of  
14 Applicants’ invention to have included the messages being graphic or video in  
15 order to achieve the above mentioned advantage.

16 The Appellants contend that (1) in Hibbeler, the message is merely audio, and  
17 thus is not "multimedia," as defined by the claim; (2) in Hibbeler, the message  
18 body does not vary from recipient to recipient, an audio of the recipient's first name  
19 is a "greeting segment" and is simply placed before the message body; (3) in  
20 Hibbeler, there is no selection of message content based on (but different from  
21 just) the individual recipient information; (4) in Hibbeler, the message is sent and  
22 is not changed when sent, whether digital or not (Br. 11).

23 We disagree with the Appellants as to the last three arguments. In each case  
24 the argument is not commensurate with the scope of the claim. Claim 1 does not

distinguish between the message body and greeting, but refers to content which necessarily includes both greetings and body. Claim 1 does not further limit the manner of individualizing content, and in particular does not exclude individualization by the individual recipient information. Claim 1 does not use the term “change” but instead requires that content is assembled from selected elements within the content repository which are selected in response to individual information about each of said recipients whose individual information is extracted from the recipient information repository. Clearly Hibbeler’s selection of a greeting segment and adding that to a body is an assembly of content.

This is where we must depart from the Examiner. The Examiner found that Hibbeler describes a means for creating and delivering multimedia content over the network (Answer 3). This finding is in error. Hibbeler describes its distribution of its messages using a message controller, a telecommunications card, and a communication link. In the preferred embodiment, the communication link is a telephone line. The telecommunications card is capable of handling communications over multiple phone lines and hence able to rapidly transmit outbound messages. In the preferred embodiment, the telecommunications card is a telephony card capable of transmitting telephone messages over a telephone line (FF 05).

Thus, the Appellants correctly contend that Hibbeler does not describe any device distributing multimedia, i.e. combined media (FF 01 & 02). In fact, Hibbeler only describes apparatus for distributing audio content. Neither reference describes distributing multimedia (FF 08).

Although the Examiner took official notice that it is old and well known to deliver messages in graphic and video format in order to provide a visual

1 representation of the data received, nothing in Hibbeler suggests, or would even  
2 have the capacity to distribute such content. The Examiner has simply placed no  
3 evidence that one of ordinary skill knew to distribute multimedia content from a  
4 messaging service in the rejection. Accordingly the Examiner has failed to present  
5 a prima facie case. Each of the remaining independent claims, included within this  
6 rejection, contains a similar limitation regarding distribution of multimedia. Each  
7 of the dependent claims necessarily includes such a limitation by virtue of  
8 incorporating the limitations from the independent claims.

9 The Appellants have sustained their burden of showing that the Examiner erred  
10 in rejecting claims 1-15, 18-33, 35-63, and 71-78 under 35 U.S.C. § 103(a) as  
11 unpatentable over Hibbeler and Official Notice.

12 *Claims 16, 17, 34, 35, and 75-78 rejected under 35 U.S.C. § 103(a) as*  
13 *unpatentable over Hibbeler, Smith, and Official Notice.*

14 Each of these claims depends from the independent claims in the prior  
15 rejection. Smith provides no evidence to overcome the deficiencies in the  
16 independent claim rejections. Accordingly, the Appellants have sustained their  
17 burden of showing that the Examiner erred in rejecting claims 16, 17, 34, 35, and  
18 75-78 under 35 U.S.C. § 103(a) as unpatentable over Hibbeler, Smith, and Official  
19 Notice.

#### 20 CONCLUSIONS OF LAW

21 The Appellants have sustained their burden of showing that the Examiner erred  
22 in rejecting claims 1-63 and 71-78 under 35 U.S.C. § 103(a) as unpatentable over  
23 the prior art.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-15, 18-33, 35-63, and 71-78 under 35 U.S.C. § 103(a) as unpatentable over Hibbeler and Official Notice is not sustained.
- The rejection of claims 16, 17, 34, 35, and 75-78 under 35 U.S.C. § 103(a) as unpatentable over Hibbeler, Smith, and Official Notice is not sustained.

REVERSED

JRG

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